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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/498,515	02/04/2000	Howard G. Page	1285	8911

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KSOPHT0101-Z2100  
OVERLAND PARK, KS 66251-2100

EXAMINER
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YOUNG, JOHN L

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 07/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**Application No.  
**09/498,515**

Applicant(s)

Page et al.,

Examiner

**John Young**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Jun 3, 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**THE PERIOD FOR REPLY [check only a) or b)]**

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see NOTE below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

**NOTE:** \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_

4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See attached ADVISORY AFTER FINAL AMENDMENT CONSIDERED

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: 1-8, 10-18, 20-23, and 25-27

Claim(s) withdrawn from consideration: \_\_\_\_\_

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☐ Other: \_\_\_\_\_

*Handwritten signature and date: 7-22-03*

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**ADVISORY AFTER FINAL AMENDMENT CONSIDERED**

**(PAPER # 9)**

1. The AFTER FINAL AMENDMENT (filled 06/03/03 as paper#8, not entered) has been considered but does not overcome the obviousness rejections of claims 1-8, 10-18, 20-23 & 25-27.

It is well settled by rule that “[on] the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon applicants . . . patent owner’s reply is limited to appeal in the case of rejection of any claim . . . or to amendment as specified in § 1.114 or § 1.116. Petition may be taken to the Commissioner in the case of objections or requirements not involved in the rejection of any claim. . . .” (See 37 CFR § 1.113).

It is also well settled by rule that “[after] a final rejection or other final action . . . in an application . . . amendments may be made canceling claims or complying with any requirement of form expressly set forth in a previous office action. Amendments presenting rejected claims in better form for consideration on appeal may be admitted. The admission or refusal to admit, any amendment after a final rejection . . . will not operate to relieve the application . . . from its condition as subject to appeal or to save the application from abandonment. . . . If amendments touching the merits of the application or patent under reexamination are presented after final rejection, or after appeal has been taken, or when such amendment might not otherwise be proper, they may be admitted upon a showing of

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**good and sufficient reasons why they are necessary and were not earlier presented.” (See 37 CFR § 1.116).**

### **EXAMINER’S RESPONSE TO ARGUMENTS**

2. Applicant's Amendment B/arguments (paper#8, filed 06/03/03) have been fully considered but they are not entered and are not persuasive for the following reasons:

**In this case, no “amendments were made . . . complying with . . . [some] requirement of form expressly set forth in a previous office action. . . . , no amendments are made presenting rejected claims in better form for consideration on appeal. . . .” And Amendment B is not admitted because there is no showing of good and sufficient reasons why the amendment [argument] is . . . not earlier presented.” (See 37 CFR § 1.116). Based on these reasons stated above, the amendment is not entered.**

Applicant's Amendment B/argument (paper#8, p. 8, ll. 9-24) alleges that “Neither Merriman nor Srinivasan . . . [nor] Rangan [provide] the ability to disable a fast-forward capability when the selected video advertising is displayed.”

It is well settled in the law that “In considering disclosure of reference patent, it is pertinent to point out not only specific teachings of patent but also the **reasonable inferences** which one skilled in the art would logically draw therefrom.” *In re Shepard*, 138 USPQ 148 (CCPA 1963).

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It is well settled in the law that a reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including non-preferred embodiments. (See *Merck & Co. Inc. V. Biocraft Laboratories Inc.*, 10 USPQ2d 1843 (CAFC 1989).

It is well settled that the test for obviousness is not whether the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the teachings of the references would have suggested in the broadest interpretation to those of ordinary skill in the art. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, the combined teachings of Merriman in view of Srinivasan and particularly in view of Rangan (col. 13, ll. 4-15), based on reasonable inferences which one skilled in the art would logically draw from the broadest interpretation of said references, reasonably suggest “the ability to disable a fast-forward capability when the selected video advertising is displayed. . . .”; for example,

Rangan (col. 26, ll. 26-60) discloses “the . . . VCR of each SUV. . . .”

Rangan (col. 13, ll. 4-15) discloses: “the particular SUV

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*[subscribers/users/viewers] will receive a variously customized regimen of both overt and covert commercials. Overt commercials are those that appear unless the SUV makes some effort, such as 'fast-forward' . . . to avoid them. . . ."*

The Examiner interprets these disclosures as showing general "VCR" capabilities to include "fast-forward" capability. In particular, the disclosure of Rangan (col. 13, ll. 4-15), i.e., "*the SUV makes some effort, such as 'fast-forward' . . . to avoid them. . . .*" suggests that the "fast-forward" is disabled to allow the "Overt commercials" to appear.

In response to Applicant's Amendment B/argument (paper#8, p. 8, ll. 25-26; & p. 9) which asserts that "Applicants submit that there are numerous additional reasons in support of patentability, but that such reasons are moot in light of the above remarks and are omitted in the interests of brevity. . . .", it is noted that Applicant's argument amounts to a general allegation that the claims of the instant application define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

**FINAL ACTION MAINTAINED**

### **CONCLUSION**

3. Any response to this action should be mailed to:

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Any response to this action may be sent via facsimile to either:

(703)305-7687 (for formal communications EXPEDITED PROCEDURE) or

(703) 305-7687 (for formal communications marked AFTER-FINAL) or

(703) 746-7240 (for informal communications marked PROPOSED or DRAFT).

Hand delivered responses may be brought to:

Seventh Floor Receptionist  
Crystal Park V  
2451 Crystal Drive  
Arlington, Virginia.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801. The examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

  
John L. Young

Patent Examiner

July 22, 2003